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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91203410
Party	Defendant East West Bank
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Serial No. 85/319,594
For the mark “EAST WEST BRIDGE FORUM”

In the Matter of Trademark Registration No. 3,448,481
Registered on June 17, 2008
For the mark “EAST-WEST BUSINESS BRIDGE”

EAST WEST BANK)	
)	
)	
Petitioner,)	Opposition No. 91203410
)	
v.)	<i>[Consolidated with]</i>
)	
THE PLUBELL FIRM, LLC)	Cancellation No. 92053712
)	
Respondent.)	
)	

PETITIONER EAST WEST BANK’S ANSWER TO COUNTERCLAIMS

Petitioner East West Bank (“Petitioner”) by and through its attorneys for its Answer to Respondent The Plubell Firm LLC’s (“Respondent”) Counterclaims, hereby states as follows:

FACTUAL BACKGROUND

U.S. Registration No. 2,025,824 – EAST WEST BANK word mark

1. As to the allegations set forth in Paragraph 1 of the Counterclaims, Petitioner admits that East-West Federal Bank, F.S.B., a United States corporation, filed Application Serial No. 74/471,889 to register the word mark EAST WEST BANK on or about December 17, 1993, prior to the conversion from East-West Federal Bank, F.S.B. to East West Bank on or about July 1995. Pursuant to both Title 12 of the United States Code and the California Financial Code,

Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 1 of the Counterclaims.

2. As to the allegations set forth in Paragraph 2 of the Counterclaims, Petitioner admits that it filed articles of incorporation with the State of California pursuant to the conversion from East-West Federal Bank, F.S.B., a United States corporation, to East West Bank, a California corporation, on or about July 1995. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 2 of the Counterclaims.

3. As to the allegations set forth in Paragraph 3 of the Counterclaims, Petitioner admits that Exhibit A speaks for itself, and that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 3 of the Counterclaims.

4. As to the allegations set forth in Paragraph 4 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent

not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 4 of the Counterclaims.

5. As to the allegations set forth in Paragraph 5 of the Counterclaims, Petitioner admits that U.S. Registration No. 2,025,824 for the word mark EAST WEST BANK is pleaded in the subject proceedings; and that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 5 of the Counterclaims..

6. As to the allegations set forth in Paragraph 6 of the Counterclaims, Petitioner admits that Exhibit B speaks for itself and was signed by Douglas P. Krause, and that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 6 of the Counterclaims.

7. As to the allegations set forth in Paragraph 7 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether

executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing; and that the Declaration of Use described in Paragraph 7 was signed by Douglas P. Krause. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 7 of the Counterclaims.

8. As to the allegations set forth in Paragraph 8 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 8 of the Counterclaims.

9. As to the allegations set forth in Paragraph 9 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 9 of the Counterclaims.

10. As to the allegations set forth in Paragraph 10 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent

not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 10 of the Counterclaims.

11. As to the allegations set forth in Paragraph 11 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing; and that the Declaration of Use described in Paragraph 11 was signed by Douglas P. Krause. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 11 of the Counterclaims.

12. As to the allegations set forth in Paragraph 12 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 12 of the Counterclaims.

13. As to the allegations set forth in Paragraph 13 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly

admitted herein, Petitioner denies the allegations set forth in Paragraph 13 of the Counterclaims.

14. As to the allegations set forth in Paragraph 14 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing; and that the Declaration of Use described in Paragraph 14 was signed by Douglas P. Krause. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 14 of the Counterclaims.

15. As to the allegations set forth in Paragraph 15 of the Counterclaims, Petitioner admits that the USPTO issued a Post Registration Office Action for the EAST WEST BANK mark, as maintained in the records with the USPTO, which speak for themselves. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 15 of the Counterclaims.

16. As to the allegations set forth in Paragraph 16 of the Counterclaims, Petitioner admits that Exhibit C speaks for itself, and that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 16 of the Counterclaims.

17. As to the allegations set forth in Paragraph 17 of the Counterclaims, Petitioner

admits that Exhibit D speaks for itself. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 17 of the Counterclaims.

18. As to the allegations set forth in Paragraph 18 of the Counterclaims, Petitioner admits that the USPTO concluded that Petitioner's combined Declaration of Use and Renewal of Registration met the requirements for Sections 8 and 9 of the Trademark Act. The Notices of Acceptance and Renewal are as maintained in the records with the USPTO, which speak for themselves. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 18 of the Counterclaims.

U.S. Registration No. 3,430,148 – EAST WEST BANK and Design mark

19. As to the allegations set forth in Paragraph 19 of the Counterclaims, Petitioner admits that its EAST WEST BANK and Design mark was registered on the Principal Register on May 20, 2008 under U.S. Registration No. 3,430,148 and is pleaded in the subject proceedings. The prosecution file history for U.S. Registration No. 3,430,148 is as maintained in the records with the USPTO, which speak for themselves. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 19 of the Counterclaims.

20. Petitioner denies the allegations set forth in Paragraph 20 of the Counterclaims.

21. As to the allegations set forth in Paragraph 21 of the Counterclaims, Petitioner admits that its parent company's subsidiary East West Insurance Services, Inc. provides certain insurance brokerage and consultation services. Except to the extent expressly admitted herein Petitioner denies the allegations set forth in Paragraph 21 of the Counterclaims.

22. As to the allegations set forth in Paragraph 22 of the Counterclaims, Petitioner admits that East West Insurance Services, Inc. provides certain insurance brokerage and insurance consultation services under the mark "EAST WEST INSURANCE SERVICES," but

denies that such services are not provided under the EAST WEST BANK and DESIGN mark as well. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 22 of the Counterclaims.

23. Petitioner denies the allegations set forth in Paragraph 23 of the Counterclaims.

24. Petitioner denies the allegations set forth in Paragraph 24 of the Counterclaims.

25. Petitioner denies the allegations set forth in Paragraph 25 of the Counterclaims.

26. Petitioner admits the allegations set forth in Paragraph 26 of the Counterclaims.

27. Petitioner denies the allegations set forth in Paragraph 27 of the Counterclaims.

COUNT ONE – FAILURE TO FILE SECTION 8 DECLARATION

(U.S. REGISTRATION NO. 2,025,824 – EAST WEST BANK word mark)

28. Petitioner incorporates by reference herein its responses to the allegations set forth in Paragraphs 1-27 of the Counterclaims.

29. As to the allegations set forth in Paragraph 29 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 29 of the Counterclaims.

30. As to the allegations set forth in Paragraph 30 of the Counterclaims, Petitioner admits that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether

executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 30 of the Counterclaims.

31. Petitioner denies the allegations set forth in Paragraph 31 of the Counterclaims.

**COUNT TWO – FRAUD – COMBINED DECLARATION OF USE AND
INCONTESTABILITY**

(U.S. REGISTRATION NO. 2,025,824 – EAST WEST BANK word mark)

32. Petitioner incorporates by reference herein its responses to the allegations set forth in Paragraphs 1-31 of the Counterclaims.

33. As to the allegations set forth in Paragraph 33 of the Counterclaims, Petitioner admits that on or about November 12, 2010, Petitioner filed a Section 7 Request with respect to U.S. Registration No. 2,025,824 deleting “administration of investment trusts for others; brokerage services rendered in the fields of shares and property” from the existing recitation of services. Except as explicitly admitted herein, Petitioner denies the allegations set forth in Paragraph 33 of the Counterclaims.

34. Petitioner denies the allegations set forth in Paragraph 34 of the Counterclaims.

**COUNT THREE – FRAUD – COMBINED DECLARATION OF USE AND RENEWAL
OF REGISTRATION**

(U.S. REGISTRATION NO. 2,025,824 – EAST WEST BANK word mark)

35. Petitioner incorporates by reference herein its responses to the allegations set forth in Paragraphs 1-34 of the Counterclaims.

36. Petitioner denies the allegations set forth in Paragraph 36 of the Counterclaims.

37. As to the allegations set forth in Paragraph 37 of the Counterclaims, Petitioner

admits that Exhibit C speaks for itself, and does not contain any false statements, and that pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing. Except to the extent expressly admitted herein, Petitioner denies the allegations set forth in Paragraph 37 of the Counterclaims.

38. Petitioner denies the allegations set forth in Paragraph 38 of the Counterclaims.

39. Petitioner denies the allegations set forth in Paragraph 39 of the Counterclaims.

COUNT FOUR – FRAUD – TRADEMARK APPLICATION

**(U.S. TRADEMARK REGISTRATION NO. 3,430,148 – EAST WEST BANK and Design
mark)**

40. Petitioner incorporates by reference herein its responses to the allegations set forth in Paragraphs 1-39 of the Counterclaims.

41. Petitioner denies the allegations set forth in Paragraph 41 of the Counterclaims.

42. Petitioner denies the allegations set forth in Paragraph 42 of the Counterclaims.

43. Petitioner denies the allegations set forth in Paragraph 43 of the Counterclaims.

AFFIRMATIVE DEFENSES

44. The facts set forth in Respondent's Counterclaims are insufficient to state a claim or to support a cancellation of Petitioner's Registered Marks, namely, U.S. Trademark Registration Nos. 2,025,824 and 3,430,148.

45. Respondent's non-fraud claims are barred by the doctrine of laches.

46. Respondent's non-fraud claims are barred by the doctrine of acquiescence.

47. Respondent's claims are barred by the doctrine of equitable estoppel.

48. Respondent's claims are barred by the doctrine of unclean hands.

49. Respondent's claims are barred by the doctrine of waiver.

50. The Combined Declaration of Use and Incontestability filed by Petitioner under its former name East-West Federal Bank, F.S.B. on or about July/August 2002 is not void *ab initio* as Petitioner is the owner of the EAST WEST BANK mark and U.S. Registration No. 2,025,824 therefor as a result of the conversion from East-West Federal Bank, F.S.B., to East West Bank on or about July 1995. Pursuant to both Title 12 of the United States Code and the California Financial Code, Petitioner succeeded to all rights and property of East-West Federal Bank, F.S.B. by operation of law, and any reference to East-West Federal Bank, F.S.B. in any writing, whether executed before or after the conversion, shall be deemed a reference to Petitioner to the extent not inconsistent with the other provisions of such writing.

51. Neither the Combined Declaration of Use and Incontestability filed by Petitioner under East-West Federal Bank, F.S.B. on or about July/August 2002 contained false statements nor was there any knowledge by Petitioner at any time of false representations or representations made with a reckless disregard for the truth of the allegations. Petitioner is the owner of the EAST WEST BANK mark and U.S. Registration No. 2,025,824 therefor as a result of the conversion from East-West Federal Bank, F.S.B. to East West Bank on or about July 1995. Accordingly, there was no intent by Petitioner to deceive the USPTO in securing the acceptance of Petitioner's Combined Declaration of Use and Incontestability.

52. Neither the Declaration dated May 7, 2007 filed in support of Petitioner's Combined Declaration of Use and Renewal of Registration for U.S. Registration No. 2,025,824 contained false statements nor was there any knowledge by Petitioner at any time of false

representations or representations made with a reckless disregard for the truth of the allegations. Petitioner is the owner of the EAST WEST BANK mark and U.S. Registration No. 2,025,824 therefor as a result of the conversion from East-West Federal Bank, F.S.B. to East West Bank on or about July 1995. Accordingly, there was no intent by Petitioner to deceive the USPTO in securing the acceptance of Petitioner's Combined Declaration of Use and Renewal of Registration.

53. Neither the trademark application for the EAST WEST BANK and Design mark filed by Petitioner on August 28, 2007 contained false statements nor was there any knowledge by Petitioner at any time of false representations or representations made with a reckless disregard for the truth of the allegations such that the statements were made with an intent to deceive the USPTO in the procurement of U.S. Trademark Registration No. 3,430,148.

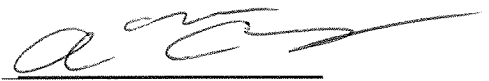
54. Petitioner reserves the right to allege other defenses, affirmative or otherwise, as may become necessary during the course of additional discovery and/or further proceedings in these consolidated proceedings, and hence reserves the right to amend this Answer to assert any such defenses.

WHEREFORE, Petitioner respectfully requests that Respondent's Counterclaims be dismissed in their entirety.

Respectfully submitted,

FOX ROTHSCHILD LLP

Dated: June 6, 2012

By: 
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **PETITIONER EAST WEST BANK'S ANSWER TO COUNTERCLAIMS** have been served on Respondent's attorneys of record by electronic mail on this June 4, 2012, addressed as follows:

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Cindy Liu
Dated: June 4, 2012